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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,580	04/20/2004	Stephen W. Bauer	200403557-1	5278

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EXAMINER

FAISON, VERONICA F

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,580

Applicant(s)

BAUER ET AL.

Examiner

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-18, 20-40 and 42-62 is/are allowed.
- 6) ☒ Claim(s) 1, 19 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 14, 36 and 58 are objected to because of the following informalities:

Claims 14, 36 and 58, Applicant recites PV19 twice in the same line. It is the position of the Examiner that the second occurrence of PV19 should be deleted. Appropriate correction is required.

Terminal Disclaimer

The terminal disclaimer filed on 4-20-05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/460,482 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 19 and 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4,

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14, 33 and 36 of copending Application No. 10/769,323. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '323 application discloses ink compositions comprising a carbon black with additional colorants selected from cyan and magenta pigments, wherein the ink composition may also be used in an ink set.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 19 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 370 580.

GB 2 370 580 teaches an aqueous ink composition comprising a black pigment which is carbon black, a phthalocyanine pigment, a dioxazine violet pigment and an aqueous carrier medium (abstract and page 3 lines 12-17). The reference remains silent to the properties set forth in claim 1. However it is the position of the Examiner that these properties are inherent because the pigments taught by GB 2 370 580 in the black ink composition are the same pigments disclosed in Applicant's specification, see pages 6-7. The reference further teaches that an aqueous pigmented ink set wherein at least one of the set of inks comprises a combination of carbon black, a phthalocyanine

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and a dioxazine violet pigment (page 7 lines 6-16). The composition as taught by GB 2 370 580 appears to anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katsen et al (US Patent 5,803,958) in view of Yatake et al (US Patent 6,767,090).

Katsen et al teach a black ink jet ink comprising water, carbon black, cyan and magenta pigments, a water immiscible organic compound exhibiting a high boiling point, and a water miscible compound (abstract, col. 2 lines 31-37 and col. 4 lines 13-20).

The reference remains silent to the properties set forth in claim 1. However it is the position of the Examiner that these properties are inherent because the pigments taught by Katsen et al in the black ink composition are the same pigments disclosed in Applicant's specification, see pages 6-7. See examples and claims. Katsen et al fail to teach the violet pigments.

Yatake et al teaches pigments for magenta include Pigment Red 1, Pigment Red 122, Pigment Red 202, and Pigment Red 209 Pigment Violet 19, Pigment Violet 32, Pigment and Violet 38 (col. 7 line 66-col. 8 line 12).

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced magenta pigments

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with violet pigments because the substitution of art recognized equivalents as shown by Yatake et al would have been within the level of ordinary skill in the art.

Claims 1, 19 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sano (US Patent 6,726,758).

Sano teaches a black ink set comprising a black ink that comprises carbon black, a magenta pigment and a cyan pigment as colorant (abstract, col. 1 lines 56-61 and col. 2 lines 4-7). The reference teaches that dispersants may be included in the ink composition such as acrylic resins (col. 4 lines 5-54). The ink set comprises the black ink as described above, in addition to at least of the following inks: a magenta ink, a cyan ink or yellow ink (col. 9 lines 21-30). The reference remains silent to the properties set forth in claim 1. However it is the position of the Examiner that these properties are inherent because the pigments taught by Sano in the black ink composition are the same pigments disclosed in Applicant's specification, see pages 6-7. See examples and claims. Sano fails to teach the violet pigments.

Yatake et al teaches pigments for magenta include Pigment Red 1, Pigment Red 122, Pigment Red 202, and Pigment Red 209 Pigment Violet 19, Pigment Violet 32, Pigment and Violet 38 (col. 7 line 66-col. 8 line 12).

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced magenta pigments with violet pigments because the substitution of art recognized equivalents as shown by Yatake et al would have been within the level of ordinary skill in the art.

Response to Arguments

Applicant's arguments with respect to claims 1, 19 and 41 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 2-18, 20-40, and 42-62 are allowed.

The following is an examiner's statement of reasons for allowance:

The references alone or in combination fail to teach a neutral black ink comprising a carbon black, a cyan pigment and a violet pigment. Therefore the references are not seen to teach or fairly suggest the claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VFF
7-8-05


J.A. LORENCO
SUPERVISORY PATENT EXAMINER